

Filed by: Merits panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-308-7953

The opinion in support of the decision being entered today is not
binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CHRISTOPHER J. STEVENS,

Junior Party,
(P.N. 5,393,368)

v.

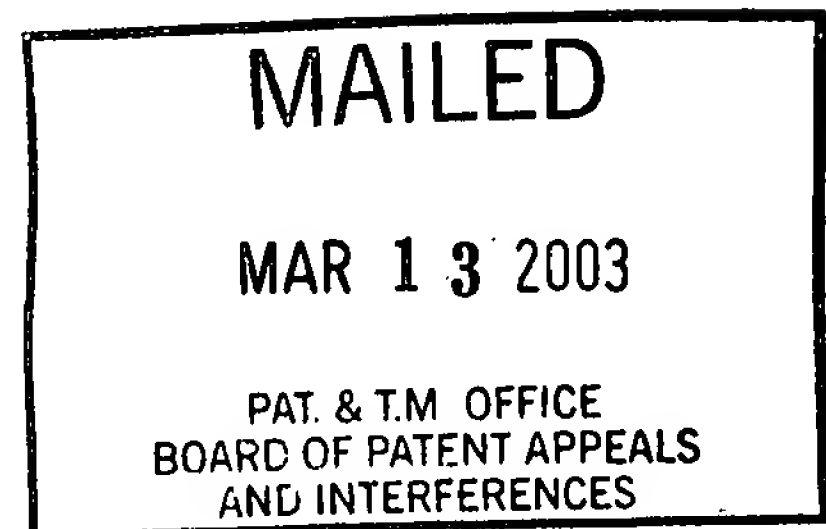
SHIGERU TAMAI,

Senior Party..
(S.N. 08/196,839)

Patent Interference No. 103,662

Before: CRAWFORD, GARDNER-LANE, and MEDLEY, Administrative Patent
Judges.

CRAWFORD, Administrative Patent Judge.



Interference No. 103,662

DECISION ON REQUEST FOR RECONSIDERATION

Tamai has requested reconsideration and modification of our FINAL DECISION mailed June 25, 2002 (hereinafter, Decision). Specifically, Tamai seeks reconsideration of that portion of the Decision that denied Tamai's motion for benefit as it relates to PCT Application No. PCT/JP92/00947 ("PCT application"). Stevens opposes the request. For the following reasons, Tamai's request for modification of the Decision is denied.

In our Decision, we noted that the PCT application is part of the file wrapper of Tamai's application Serial No. 08/030,183 (" '183 application"). Tamai was accorded the benefit for purposes of priority of the '183 application.

Section 1.637(f) of 37 CFR states in relevant part:

A preliminary motion for benefit under
§ 1.633(f) shall:

. . . When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.

Section 1.647 of 37 CFR states:

When a party relies on a document or is required to produce a document [is] in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

Clearly, as Tamai filed a motion for benefit of the filing date

Interference No. 103,662

of its PCT application, which was in Japanese, Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do.

In regard to Tamai's argument that the '183 application is a translation of the PCT application, we note that Tamai did not state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed. As such, we are not persuaded that such an alleged correspondence between the '183 application and the PCT application relieves Tamai of its obligations under 37 CFR § 1.637(f).¹ In addition, we agree with Stevens that it is not the burden of Stevens or this tribunal to look to the '183 application and determine whether it is a translation of the PCT application. Tamai argues that the provisions of 37 CFR § 1.639 obviate the need for Tamai's 1.633(f) motion to include another copy of documents already in the file wrappers of record.

The provisions of 37 CFR § 1.639 do not obviate the need for the filing of the PCT application as argued by Tamai. Section 1.639 of 37 CFR relates to evidence in support of a motion and states in relevant part that:

. . .proof of any material fact alleged in a

¹ We also note that 35 U.S.C. § 371 (c)(2) requires a translation but 37 CFR § 1.647 requires a translation and an affidavit attesting to the accuracy of the translation.

Interference No. 103,662

motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

As section 1.639 relates to evidence needed to prove a material fact in a motion while § 1.637(f) relates to documents that are required to be filed with a motion for benefit, the provisions of § 1.637(f) are not obviated by the provisions of § 1.639.

Tamai also argues that all substantive issues were readily resolved by simply referring to the embodiments shown in Figure 1 of Tamai's PCT application which was present in the file wrapper of the '183 application.

However, it was not the obligation of Stevens to go through the '183 application, find the PCT application and review the drawings to resolve substantive issues. It was Tamai's obligation to file a copy of the translation with the motion pursuant to the provisions of 37 CFR § 1.637(f).

Tamai has not met the requirements of 37 CFR § 1.637(f).

Tamai argues that it would be in the interest of justice to accord Tamai the benefit of the filing date of the PCT application notwithstanding the fact that the motion for benefit was filed without the requisite translation of the PCT

Interference No. 103,662

application. We do not agree.

It is true that we may, in accordance with the provisions of 37 CFR § 1.640(b), take such other actions as will secure the just, speedy and inexpensive determination of the interference. However, we do not consider the granting of a motion for benefit of a PCT application which was filed without a copy of the translation of that PCT application to be in the interest of a just, speedy and inexpensive determination of the interference.


First, Stevens is entitled to review a translation of the PCT application at the time the motion was filed to determine how to respond to the motion. In addition, Stevens is entitled to expect that the rules of this tribunal will be followed by all parties to this interference.

Finally, we address Tamai's argument that it is inconsistent to accord Tamai the benefit of the Japanese Patent Application No. 3-68371 ("JP '371") and not accord Tamai the benefit of the PCT application. As we stated in our decision, Stevens was in possession of a translation of the JP '371 application at the time the motion was filed and was not in possession of the translation of the PCT application. As such, in our view, any inconsistency in the treatment of the JP '371 application and the PCT application arises because of Tamai's inconsistent actions in regard to these two applications.

Interference No. 103,662

The request for reconsideration is granted to the extent that we have reconsidered our decision but denied in that we decline to make any modifications to our decision.

Murriel E. Crawford
Administrative Patent Judge


Sally Gardner-Lane
Administrative Patent Judge


Sally C. Medley
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

MEC:tdl

Interference No. 103,662

Attorney(s) for Stevens:

Charles P. Boukus, Jr.
Suite 202
2001 Jefferson Davis Highway
Arlington, VA 22202

Attorney(s) for Tamai:

William F. Westerman
1725 K Street, N.W., Suite 1000
Washington, D.C. 20006